

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

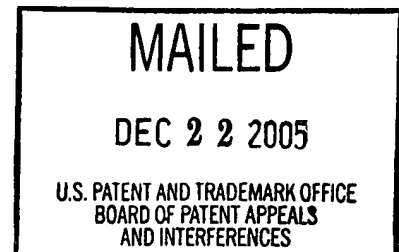
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TIMOTHY J. BRENNAN

Appeal No. 2005-1836
Application No. 10/033,632

HEARD: November 15, 2005



ELLIS, SCHEINER and ADAMS, Administrative Patent Judges.

ELLIS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the examiner's final rejection
of claims 1-5, all the claims remaining in the application. Claims 6-10 have been
canceled.

1. A method of inducing spinal anesthesia, comprising: administering spinally a small but anesthesia producing amount of 6-[2-(1(2)H-tetrazole-5-yl)ethyl]decahydroisoquinoline-3-carboxylic acid or a pharmaceutically active analogue [t]hereof to a patient in need of a spinal anesthetic.
2. The method of claim 1 wherein the administering spinally is by intrathecal administration.

As indicated by the claims above, the present invention is directed to a method of inducing spinal anesthesia. According to the specification, the use of local anesthetics is often accompanied with severe side effects. Specification, p. 1, para. 1. The specification states that one alternative to current anesthetics is the use of compounds

which block synaptic transmission in the spinal cord. Id., para. 2. The specification further states (para. bridging pp. 1-2) that

This could be accomplished by activation of inhibitory receptors or by antagonism of excitatory receptors. Glutamate is the major excitatory central nervous system neurotransmitter. Glutamate activates ionotropic excitatory amino acid (EAA) receptors that are highly prevalent in the nervous system and transmit information through both N-methyl-D-aspartate (NMDA) as well as nonNMDA EAA receptors. Ketamine, a drug used clinically in anesthesia, antagonizes NMDA receptors. . . .
[Whereas;] [i]ntrathecal non-NMDA excitatory amino acid receptor antagonists inhibit pain behaviors in a rat model of postoperative pain.

The appellant is said to have discovered that 6-[2-(1(2)H-tetrazole-5-yl)ethyl]decahydroisoquinoline-3-carboxylic acid, a potent non-NMDA receptor antagonist, "is highly effective for spinal anesthesia [] without the normal associated acute side effect of hypotension." Id., p. 2.

The examiner premises his conclusion of obviousness on the combined teachings of Arnold and Conn. With respect to the former publication, the examiner argues that Arnold discloses "formulation[s] comprising a pharmaceutically acceptable carrier together with 6-[2-(1(2)H-tetrazole-5-yl)ethyl]decahydroisoquinoline-3-carboxylic acid or a pharmaceutically acceptable salt thereof." Answer, p. 3. The examiner further argues that Arnold discloses the use of said formulations (i) as analgesic agents; and (ii) to treat physiological functions such as spinal cord trauma. Id., para. bridging pp. 3-4. With respect to Conn, the examiner argues that the publication discloses methods of spinal anesthesia delivery which include the insertion of a needle "at L3-4, on the

vertical line through the interspace but 1 cm below the ridge of the osseomuscular spinal column.” Id., p. 4. The examiner concludes that

It would have been obvious to one of ordinary skill [in the art] to use the teachings of [Conn] to select intrathecal administration as the best mode for the purposes of delivery [of] an anesthesia to the spinal cord. . . . [I]t is known in the art that when administering an anesthesia to the spinal cord that it would be done by way of intrathecal administration and example of such a practice is administering a drug during pregnancy. Id.

It is well established that the examiner has the initial burden under § 103 to establish a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). To that end, it is the examiner’s responsibility to show that some objective teaching or suggestion in the applied prior art, or knowledge generally available [in the art] would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 745 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). This the examiner has not done.

Here, we agree with the appellant that Arnold does not teach the use of 6-[2-(1(2)H-tetrazole-5-yl)ethyl]decahydroisoquinoline-3-carboxylic acid for anesthesia but, rather, the patent teaches its use as an analgesic agent. As pointed out by the appellant, an analgesic is a compound which decreases pain; whereas, an anesthesia is a compound which provides a “complete blockade of the motor and sensory response during surgery” [Brief, p. 6] so that the patient does not feel that surgery is occurring. Given that Arnold teaches the use of 6-[2-(1(2)H-tetrazole-5-yl)ethyl]decahydroisoquinoline-3-carboxylic acid for a completely different purpose (and,

we point out, administration by several different routes, but not intrathecally), we do not find that the patent would have suggested a method of using of this compound to induce spinal anesthesia to one of ordinary skill in the art. Rather, on this record, the only suggestion we find to perform said method and to administer said compound intrathecally is in the appellant's specification. Thus, we find that the examiner has engaged in impermissible hindsight to arrive at the conclusion that the claimed invention would have been obvious over Arnold and Conn. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to

the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”).

In view of the foregoing, the decision of the examiner is reversed.

REVERSED



Joan Ellis
Administrative Patent Judge



Toni R. Scheiner
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge

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